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**FAX**

#45

**Date:** February 27, 2003  
**To:** Examiner Joseph T. Woitach  
**From:** Ronald I. Eisenstein  
**Message:** Applicants: Marasco et al.

**Pages (including cover): 5**

**Fax: 1.703.305-3014**

**Ph: 1.703.305-3732**

Appln. No.: 08/822,033

Filed: March 24, 1997

**OFFICIAL**

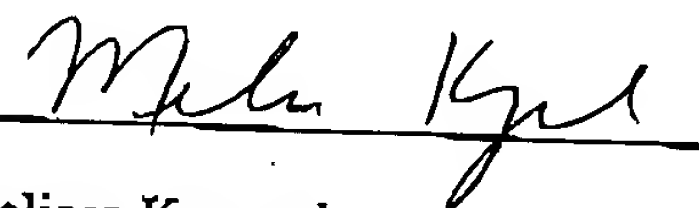
**FEB 28 2003**

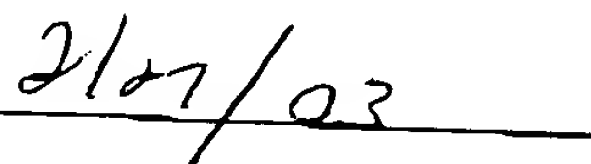
**GROUP 1600**

**For: NUCLEIC ACID DELIVERY SYSTEM, METHODS OF SYNTHESIS AND USE THEREOF**

**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that this Request for Withdrawal of Finality is being transmitted via facsimile to the Office of Finance at the Patent and Trademark office on the date shown below.

  
Melissa Kruggel

  
Date: February 27, 2003

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**To:** Examiner Joseph T. Woitach  
**From:** Ronald I. Eisenstein

**Pages (including cover): 5**

**Fax: 1.703.305-3014**

**Ph: 1.703.305.3732**

**Client/Matter:** 700157-043471

**User No.:**

**Disbursement Amount: \$**

Practitioner's Docket N . 43471-RCE2

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Marasco et al.

Application No.: 08/822,033

Group No.: 1632

Filed: 03/24/1997

Examiner: Woitach, Joseph T.

For: NUCLEIC ACID DELIVERY SYSTEM, METHODS OF SYNTHESIS AND  
USE THEREOF

Commissioner for Patents and Trademarks  
Washington, D.C. 20231

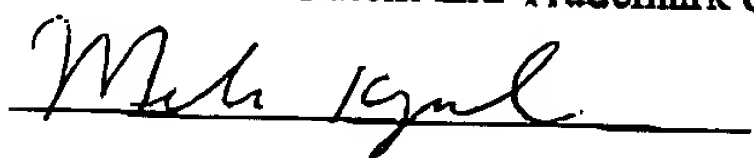
**REQUEST FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION, OR IN THE  
ALTERNATIVE CONDITIONAL PETITION FOR WITHDRAWAL OF FINALITY**

Applicants respectfully submit that the finality of the Office Action dated February 11, 2003 was improper and should be withdrawn, for the following reasons:

1. On May 28, 2002, a Final Office Action was mailed in the parent application (serial number 08/822,033, filed March 24, 1997).
2. On October 28, 2002, applicants filed an Amendment after Final Rejection Under 37 C.F.R. 111.6, and Petition or Extension of Time.
3. On November 18, 2002, an Advisory Action (paper no. 40) was mailed, indicating that the proposed Amendment would not be entered because it raised new issues that would further consideration and/or search [copy attached hereto].
4. Accordingly, on November 26, 2002, applicants filed an RCE application, including the previously submitted Amendment and the requisite fee.

**CERTIFICATE OF FACSIMILE TRANSMISSION**

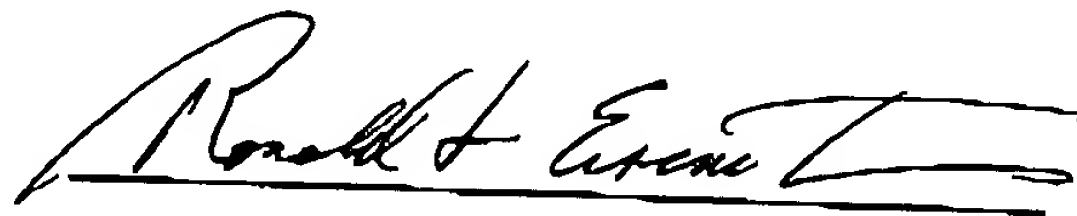
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Melissa Kruggel

Date: February 27, 2003

5. On February 11, 2003 in response to the filing the RCE, a Final Office Action was mailed, indicating that the application was eligible for continued examination under 37 C.F.R. 1.114, and that the proper fee had been paid. The Examiner entered the Amendment filed November 26, 2002, but made the Office Action "final".
6. MPEP 706.07(h), Section VIII, sets forth the conditions required for issuing a First Action Final After Filing an RCE, stating in relevant part: "The action immediately subsequent to the filing of an RCE with a submission and fee under 37 CFR 1.114 *may be made final only if the conditions set forth in MPEP § 706.07(b) for making a first action final in a continuing application are met.*" [emphasis added]
7. MPEP § 706.07(b) explicitly states "it would not be proper to make final a first Office action in a continuing or substitute application where that material which was presented in the earlier application after final rejection ... *was denied entry because (A) new issues were raised that required further consideration and/or search...*" [emphasis added]
8. That is precisely the situation that has occurred here.
9. Accordingly, applicants respectfully submit that the finality of the Office Action dated February 11, 2003, was not proper, and respectfully request its withdrawal.
10. In the event that the Examiner does not grant this request to withdraw the finality of the Office Action, please consider this a Petition Under 37 CFR 1.181 to the Commissioner to withdraw finality due to prematurity of final rejection, MPEP § 706.07(c). (See MPEP § 1002(02)(c)(3)(a).) The Commissioner is authorized to charge any fee due in connection with this petition to Deposit Account No. 50-0850.
11. Applicants believe no fee is due. However, please charge any required to Deposit Account No. 50-0850.



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## UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/822,033	03/24/1997	WAYNE A. MARASCO	43471-EWC RCE	5884

7590 11/18/2002  
Ronald I. Eisenstein  
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101 Federal Street  
Boston, MA 02110

EXAMINER

WOITACH, JOSEPH T

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 11/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

